

### Remarks

A. Claim 7 has been cancelled by the present amendment .

B. Claim 1 stands rejected under 35 U.S.C. 102(b) as being anticipated by the international reference to Techboot WO 92/14372 ("WO '372"). In order for a claim to be anticipated, each and every element of the claim must be present in the reference. In the present case, independent claim 1 recites that the layer of compressible cold insulating material is secured to the inside of the toe box in its uncompressed state. However, as seen most clearly in Figures 2 and 4 of the WO '372 patent, at least a section of the non-flammable ester foam lining 43 is secured inside the toe box in its compressed state and not in its uncompressed state as recited in claim 1. The Examiner's attention is directed, in particular, to that section of the non-flammable ester foam lining 43 under toe cap 27 which is of substantially less thickness than the remainder of foam lining 43 and is therefore in its compressed state. Accordingly, since the lining 43 of WO '372 is not in its uncompressed state, claim 1 is not anticipated by WO '372.

C. Claims 1, 5 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over WO '372 in view of Official Notice. For the same reason that WO '372 does not anticipate claim 1, i.e., that lining 43 is not in its uncompressed state, so, too, WO '372, when modified as proposed by the Examiner, does not render claims 1, 5 and 6 unpatentable.

D. Claims 1, 5 and 6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over White 3,805,413 or Adams 4,102,062 in view of WO '372.

(i) White

Applicant's invention is directed to a boot in which an outer layer of leather is

stretched over the toe area of the boot during the manufacturing process. To prevent compression of the cold insulating material (and reduction of its cold insulating properties) by the stretching of the leather during the manufacturing process, an oversized toe box is provided so that the insulating material may be secured to the inside of the toe box.

The manufacturing process of the White footwear is distinctly different. White utilizes an essentially finished footwear in which a completely pre-assembled toe cap is inserted into the toe region of the finished footwear. See, for example, col. 5, lines 13-17.

“It is believed that the present invention is the first that accomplishes insertion of a complete toe cap and lining assembly into an essentially finished footwear article of any type such as for example a molded footwear article or a machine-made shoe ...”

Claim 1 of the present application, as presently amended, recites that the outer layer of leather is manually or mechanically stretched over the oversized toe box. No such stretching occurs in the White footwear. Further, there is no reason to believe that the toe box of White is oversized. Thus, assuming arguendo, that it would have been obvious to provide White with an outer layer of leather, the modified footwear would nevertheless not have included an outer layer of leather manually or mechanically stretched over an oversized toe box. Accordingly, it is respectfully submitted that claims 1, 5 and 6 are patentable over White in view of WO ‘372.

(ii) Adams

In Adams, there is no indication that toe box 12 shown in FIGS. 1 and 3 is oversized. The drawings of Adams disclose a toe box which appears to be of conventional size and, in fact, Adams recites that metal toe protector 12 is of the type that is fairly conventional (see, col. 1, lines 64-68).

Further, there would not have been any motivation to make the Adams boot of

leather, as proposed by the Examiner, to aid in protecting the user's foot from impacts. There would not have been any such motivation to so modify Adams because the wearer's foot is already fully protected from very heavy impact loads as a result of metatarsal guard 13 and toe protector element 12. As Adams recites at column 3, lines 19-30:

“Referring again to **FIG. 2**, should a heavy weight fall from above on the foot portion of the boot, the impact force will be mainly applied to the central section **28** of guard **13** and transmitted down the sides to be distributed and absorbed at the sole. Under severe impact which might temporarily slightly deform the central section **28** the force is either not passed on to the wearer's foot or is cushioned by layer **23**. The guard **13**, even under very heavy impact loads, will strongly resist any change in its shape or position, and the sides **27** and **28** will not tend to spread outwardly under impact or crushing so that the wearer's foot is fully protected.”

Thus, the substitution of a leather outer layer in Adams would not have added any impact protection to the already fully protected Adams boot and there would not have been any motivation to form the Adams boot of leather. It is therefore respectfully submitted that claims 1, 5 and 6 are patentable over Adams in view of WO '372.

In view of the foregoing, it is submitted that claims 1, 5 and 6 are patentable over the cited prior art, either singly or in combination.

Dated: February 18, 2004

Respectfully submitted,



---

Milton Wolson  
MALINA & WOLSON  
60 East 42<sup>nd</sup> Street  
New York, NY 10165  
(212) 986-7410  
Attorney for Applicant